

### **Remarks**

The Examiner is thanked for the thorough examination of this application. The Office Action has, however, tentatively rejected all claims.

Specifically, the Office Action tentatively rejected claims 9-13 under 35 U.S.C. 102(e) as allegedly anticipated by Dadafshar (US 6,420,953). The Office Action also rejected claim 14 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of Dadafshar in view of Inoh (US 5,521,573). Applicants respectfully traverse the rejection made by the Examiner for the reasons discussed below.

Claim 9 recites a filtering induction device comprising a first coil, a second coil, and a core structure. The first coil has a plurality of circles and the second coil also has a plurality of circles. Among other features, claim 9 specifically recites: “*a second coil having a plurality of circles interlacing with the plurality of circles of the first coil.*” In contrast, Dadafshar appears to disclose a multi-layer, multi-functioning printed circuit board including an upper core portion 510, a lower core portion 520, a secondary copper plate 540, and PCB’s 525, 530 and 535. The secondary copper plate 540 and the PCB’s 525,530,535 are stacked together one by one (as represented in Fig. 7). That is, the secondary copper plate 540 and the PCB’s 525, 530,535 do not interlace with each other via the circles.

Dadafshar does not teach the claimed feature of the first and second coils interlacing with each other via the circles. For at least this reason, Claim 9 patently defines over the cited art. As claim 9 patently defines over the cited art, dependent claims 10-14 patently define over the cited art as well.

In addition, claim 14 was rejected under 35 U.S.C. 103 (a) as allegedly unpatentable over Dadafshar in view of Inoh. Applicants submit that the Office Action has failed to identify a

proper motivation or suggestion for combining the selected teachings of Inoh with Dadafshar. In this regard, the Office Action merely alleged that the combination would have been obvious "for the purposes of improving high frequency insulating characteristics. Applicants respectfully submit, however, that this bear (unsupported) allegation fails to satisfy the legal requirements that the well-established patent laws place on the Patent Office. In this regard, it is well settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to realize a filtering induction device, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must

be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczkak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczkak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

In rejecting independent claim 14, the Office Action has failed to comply with the legal standards set forth above. Specifically, in combining the two patents, the Office Action states only: “It would have been obvious to one of ordinary skill in the art at the time the invention was made to

ground the secondary coil terminal of Dadafshar, as suggested by Inoh et al., for the purpose of improving high frequency insulating characteristics."

This approach reflects a fundamental misunderstanding of the law or a fundamental misapplication under the legal standards set out by the Federal Circuit. It is insufficient merely to allege that it would be obvious to combine general teachings of two separate patents. Instead, it is incumbent upon the Patent Office to articulate reasons as to why one skilled in the art would selectively combine specific elements of the two patents to render obvious the feature claimed in claim 14. The Office Action has failed to do this.

In addition, the conclusion reached by the Office Action is inadequate as a matter of law to provide the required suggestion or motivation to combine selective teachings from multiple prior art references. Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion is "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988). A description of the particular "teaching or suggestion or motivation [to combine]" is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, "the [Examiner] must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." *In re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998). The Examiner can satisfy this burden of establishing obviousness in light of combination "only by showing some objective teaching [leading to the combination]." *In re Fritch*, 972 F.2d 1260, 1265 (Fed.Cir.1992).

Simply stated, the Office Action has failed to comply with these legal standards. Consequently, the rejection of claim 14 is legally improper and must be withdrawn. For at least the foregoing reasons, Applicant respectfully submits that the rejection of this claim should be withdrawn.

**Cited Art**

The cited art made of record, but not relied upon, has been considered but is not believed to impact the patentability of the pending claims.

For at least the foregoing reasons, all claims 9-14 are believed to be in condition for allowance, and the Examiner is respectfully requested to pass those claims to issuance. If the Examiner believes a teleconference will expedite the examination of this application, the Examiner is invited to contact the undersigned attorney at 770-933-9500.

No fee is believed to be due in connection with this Preliminary Amendment. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,



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